



PTO/SB/21 (02-04)
Approved for use through 07/31/2006, OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number 09/258,216	Filing Date 26 February 1999
First Named Inventor SODERLUND, Hans E.	Art Unit 1634
Examiner Name SITTON, Jehanne Souaya	
Total Number of Pages in This Submission	Attorney Docket Number 13025-5

ENCLOSURES <i>(Check all that apply)</i>		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please Identify below): Reply to a Notice of Non-Compliant Amendment under 37 CFR 1.121 Receipt Acknowledgement Postcard
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	J. David Elliott, Jr.
Signature	
Date	5 May 2004

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name	J. David Elliott, Jr.
Signature	
Date	5 May 2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



1634

Patent

62616.1

Attorney Docket 13025-5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Applicants: SODERLUND, Hans E. and)
SYVANEN, Anne-Christine) Examiner: SITTON, Jehanne Souaya
Serial No.: 09/258,216)
Filed: 26 February 1999) Group Art Unit: 1634
For: "Method and Reagent for Determining)
Specific Nucleotide Variations")

Kalow & Springut LLP
488 Madison Avenue, 19th Floor
New York, New York 10022

5 May 2004

Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

**REPLY TO A NOTICE OF NON-COMPLIANT
AMENDMENT UNDER 37 CFR 1.121**

SIR or MADAM:

This is in reply to a notice of non-compliant amendment issued on 5 April 2004 with respect to a reply to an office action filed on 1 April 2004 with a request for continued examination (RCE) in connection with the patent application identified above. The present reply

Certificate of Mailing Under 37 CFR 1.8

I hereby declare that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Post Office Box 1450, Alexandria, VA 22313-1450, on

5 May 2004

Date

J. David Ellett, Jr. (Reg. No. 27,815)

Applicants: Soderlund, Hans E., and Syvanen, Anne-Christine

Filing Date: 26 February 1999

Serial No.: 09/258,216

Page 2

is being submitted to the Patent and Trademark Office by mail with a certificate of mailing on 5 May 2004, the day set for a reply.

In the outstanding notice of non-compliant amendment, it was asserted that the reply of 1 April 2004 failed to meet certain requirements of 37 CFR 1.121. In particular, it was asserted that the amendments to the claims in the reply of 11 March 2004 did not include a complete listing of all of the claims. The notice of non-compliant amendment required that only corrected sections of the assertedly non-compliant amendment document be resubmitted in their entirety.

The attorneys for the applicants respectfully submit that the amendments to the claims in the reply of 1 April 2004 fully complied with 37 CFR 1.121. In particular, 37 CFR 1.121(c) specifies that “[e]ach amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application.” [Underlining added.] As pointed out in the section of the reply of 1 April 2004 involving amendments to the claims of the subject application, the subject application was a continued prosecution application (CPA) which was filed on 26 September 2002. The listing of claims in the section of the reply of 1 April 2004 involving amendments to the claims was an accurate listing of all the claims of the subject continued prosecution application filed on 26 September 2002.

In a telephone conference with the undersigned attorney on 1 April 2004 in connection with a notice of non-compliant amendment issued with respect to related application 08/466,322, attorney Robert J. Spar of the Office of Patent Legal Administration of the Patent and Trademark Office indicated that, notwithstanding the language in 37 CFR 1.121(c) calling for a complete listing of all claims “in the application” and the fact that a continued prosecution application (CPA) is a separate application from the parent application on which the continued prosecution application is based, the Patent and Trademark Office expected a continued prosecution

Applicants: Soderlund, Hans E., and Syvanen, Anne-Christine

Filing Date: 26 February 1999

Serial No.: 09/258,216

Page 3

application and its immediate parent application to be treated as a single application for purposes of compliance with the requirements of 37 CFR 1.121(c).

Although the attorneys for the applicants maintain that the claim listing in the amendments-to-the-claims section of the reply of 1 April 2004 was fully compliant with the express wording of 37 CFR 1.121(c) and that the objections to the reply set out in the notice of non-compliant amendment of 5 April 2004 were without merit, to expedite prosecution of the subject application, an alternative amendments-to-the-claims section for the reply of 1 April 2004 is set out below which ignores the distinction between the subject continued prosecution application (CPA) filed 26 September 2002 and its immediate parent application of the same application number filed on 26 February 1999.

Authorization is hereby given to the Patent and Trademark Office to enter in the file of the subject application, at the Office's election, the alternative amendments-to-the-claims section for the reply of 1 April 2004 set out below which ignores the distinction between the subject continued prosecution application (CPA) and its immediate parent as a replacement for the amendments-to-the-claims section of the reply of 1 April 2004 as originally filed which, it is respectfully submitted, properly took account of the distinction between the subject continued prosecution application and its immediate parent.